

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCE

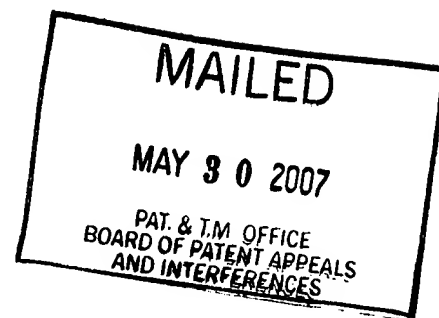
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Ex parte WILLIAM J. FURNAS

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Application 09/318,249

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ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

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This application was electronically received at the Board of Patent Appeals and Interferences (BPAI) on March 19, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner. The matters requiring attention prior to docketing are identified below.

**APPEAL BRIEF**

A review of the file indicates that on January 9, 2006, Appellants filed an Appeal Brief. A review of the file reveals that the "Summary of Claimed Subject Matter" does not map the independent claim to the specification, as set forth in 37 CFR § 41.37(c)(1)(v) which states:

(v) Summary of claimed subject matter. A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.

Correction of the Appeal Brief is required.

### **EXAMINER'S ANSWER**

On January 25, 2006, an Examiner's Answer was mailed. A review of the Examiner's Answer reveals that it is not in compliance with the headings as required under 37 CFR § 41.37(c).

An in-depth review of the Examiner's Answer mailed on January 25, 2006, 2005, reveals that under the heading Evidence Relied Upon, all of the prior arts relied on was not listed. Ishikawa, U.S. Patent No. 4,924,083 was not listed under the heading Evidence Relied Upon, but was used in rejecting claim 2 under 35 U.S.C. § 103(a) on page 5, of the Examiner Answer. The MPEP 1207.02(A) states:

A) CONTENT REQUIREMENTS FOR EXAMINER'S ANSWER. The examiner's answer is required to include, under appropriate headings, in the order indicated, the following items:

(8) Evidence Relied Upon. A listing of the evidence relied on (e.g., patents, publications, admitted prior art), and, in the case of nonpatent references, the relevant page or pages.

Correction of the Examiner's Answer is required.

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) hold the Appeal Brief filed on January 9, 2006, defective;
- 2) notify appellant to file a "paper" providing the "Summary of Claimed

Subject Matter" as required under 37 CFR § 41.37;

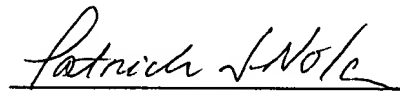
- 3) issue and mail a form PTOL-90 considering Appellant's "paper"

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(Summary of Claimed Subject matter) and identifying all the references relied upon in the rejection of the claims on appeal; and

4) for such further action as may be appropriate.

BOARD OF PATENT APPEALS  
AND INTERFERENCES

A handwritten signature in cursive script, reading "Patrick J. Nolan", is written over a horizontal line.

PATRICK J. NOLAN  
Deputy Chief Appeals Administrator  
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PJN/pgc

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